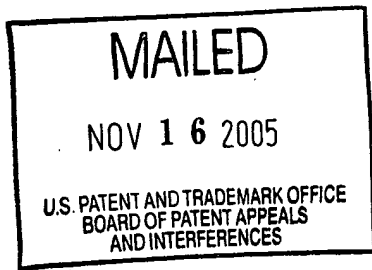


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte MASANOBU IWASAKI
and
YOSHIO HAYASHIDE

Appeal No. 2005-2579
Application 09/934,474

ORDER REMANDING TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 17, 2005.

An examination of the Image File Wrapper (IFW) has revealed that the language of claims 1, 6, 8, 9 and 15 appearing in the Appendix to the Appeal Brief filed November 4, 2002 differs from its last amended version. 37 CFR § 1.192(c)(9) (2002) requires that the Appendix to the Appeal Brief contain a correct copy of the claims involved in the appeal. Specifically, the problems are as follows:

Claim 1 - line 9 contains duplicate text ("supply unit and the mist of pure water supplied from said" - see Amdt. A filed March 4, 2002)¹;

Claim 6 - lines 2 and 3 contain duplicate text ("organic acid, or an aqueous solution of" - see Amdt. A filed March 4, 2002);

Claim 8 - line 1 contains extra word ("comprising" - see Amdt. A filed March 4, 2002);

Claim 9 - line 1 contains extra word ("comprising" - see Amdt. A filed March 4, 2002); and

Claim 15 - lines 13-15 of Amdt. A filed March 4, 2002 contain an unequal amount of brackets ("[in the an apparatus for polishing a semiconductor substrate [according to claim 9], the method comprising [the steps of,]"). It is noted that the above language does not appear in the Appendix to the Brief.

Clarification regarding the language involved in claim 15 and correction of the above additional discrepancies is required.

In addition, a Reply Brief was filed on January 22, 2003 in response to the Examiner's Answer mailed November 22,

¹This varies slightly from the error noted on page 2, section (8), of the Examiner's Answer mailed November 22, 2002.

2002. On March 18, 2003, an Office communication was mailed which appeared to include rebuttal. 37 CFR § 1.193 (2002) reads, in part, as follows:

§ 1.193 Examiner's answer and reply brief.

. . . .

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such examiner's answer or supplemental examiner's answer The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted [emphasis added].

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Entry of the examiner's Office communication mailed March 18, 2003 is inappropriate.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. to clarify the amendment to claim 15;
2. to notify appellants to submit a corrected Appendix to replace the existing defective appendix, or for the examiner to issue a supplemental Examiner's Answer to officially correct claims 1, 6, 8, 9 and 15;
3. for a proper response to the Reply Brief filed January 22, 2003; and
4. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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